

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PHILIPPE DOMANSKY

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Appeal No. 2000-0845  
Application No. 08/617,829

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 24-31 and 34-36.<sup>1</sup>

We AFFIRM-IN-PART.

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<sup>1</sup>Claims 1-23, 33 and 38 have been canceled, and claims 32 and 37 have been indicated as containing allowable subject matter if rewritten in independent form (Paper No. 16).

### BACKGROUND

The appellant's invention relates to a divider panel for separating layers of stacked articles from one another. An understanding of the invention can be derived from a reading of exemplary claim 24, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bakx	4,932,531	Jun. 12, 1990
European Patent Application	0 595 602 A1	May 4, 1994

Claims 24-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the European Patent Application.

Claims 34-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bakx.

Claims 28-31 stand rejected under U.S.C. § 103 as being unpatentable over the European Patent Application in view of Bakx.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 26) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 23) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### The Rejections Under Section 102

Independent claim 24 is directed to a divider panel for separating each one of at least two tiers of stacked articles from one another wherein the tops and bottoms of the articles are nestable within one another, and defines the divider panel as comprising

a sheet including at least one substantially continuous annular-shaped member disposed for operable engagement between the tops and bottoms of the articles.

This claim stands rejected as being anticipated by the divider disclosed in the European Patent Application. Of course, anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention,<sup>2</sup> which means that all of the subject matter recited in claim 24 must be disclosed or taught by the European reference. The dispositive issue is whether the European reference discloses the “substantially continuous annular-shaped

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<sup>2</sup>See, for example, RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984).

member” required by the claim. The examiner urges that each of the sixteen arcuate-shaped tabs 38 shown in Figure 3 of the reference constitutes a substantially continuous annular-shaped member or, in the alternative, that the complete set constitute the required structure (Answer, page 4). The appellant argues that this is not the case (Brief, page 5). We find ourselves in agreement with the appellant, based upon the following rationale.

The common definition of annular is “of, relating to, or forming a ring.”<sup>3</sup> As is clearly shown in Figure 12 of the appellant’s drawings, element 62d meets this definition, for it forms a continuous ring that is only partially cut through at two locations. This is confirmed by the manner in which it is described on page 10 of the specification:

The deformable portion 62d comprises a movable tab 74d which is defined by a continuous inner circular cut 68d and a discontinuous outer, substantially circular cut 70d. The outer cut 70d comprises inwardly extending end portions 71d which can be used to help enable greater deformity of a deformable portion 62d in use and possibly prevent tearing. The tab 74d is hingably connected to the rest of the panel by hinges 75d created by discontinuous outer cut 70d.

We therefore interpret “annular-shaped member” to mean a member that transcribes a ring, and “substantially continuous” to mean that its continuity can be partially disturbed at only a few places. Each of the tabs 38 in the European reference fails to meet the terms of the claim because it constitutes only a portion of a ring. All of the tabs 38, taken together, fail to meet the terms of the claim because they do not constitute a “substantially

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<sup>3</sup>See, for example, Merriam Webster’s Collegiate Dictionary, Tenth Edition, 1996, page 47.

continuous” ring, in view of the fact that any “member” that might be considered to be formed by them is completely severed at seventeen places.

It therefore is our conclusion that the European Patent Application fails to disclose or teach all of the subject matter recited in claim 24, and we will not sustain the Section 102 rejection of independent claim 24 or dependent claims 25-27.

Independent claim 34 stands rejected as being anticipated by Bakx. Looking to Bakx’s Figure 1, we understand the examiner’s position to be that the inward edges of upstanding end tabs 58 and 60 at the point where they intersect side panels 32 and 36, and the outward edges of center recesses 38 at the side panels, together form the required “means for cooperating with articles underlying one of the tiers of stacked articles to help maintain the relative position of the sheet therewith,” in that they interlock with top flanges 44 of the underlying articles. We are not persuaded that this position is in error by the appellant’s argument on page 5 of the Brief (lines 25-30), particularly in view of the very broad language of the claim.

The Section 102 rejection of claim 34 is sustained. Because the appellant has chosen to allow dependent claims 35 and 36 to stand or fall with claim 34, from which they depend (Brief, page 5, lines 8-10), the rejection of these claims also is sustained.

The Rejection Under Section 103

Claims 28-31 stand rejected as being unpatentable over the European Patent Application in view of Bakx.

Claims 28-31 are dependent from claim 24, and thus include all of the limitations of claim 24. As we determined above in the rejection of claim 24 under Section 102, the European Patent Application fails to disclose or teach the annular-shaped member required by the claim. No such member is disclosed or taught by Bakx. It therefore is our opinion that, considering the two references in the light of Section 103,<sup>4</sup> their combined teachings fail to establish a prima facie case of obviousness with regard to the subject matter of claims 28-31, and we will not sustain this rejection.

#### SUMMARY

The rejection of claims 24-27 under 35 U.S.C. § 102(b) as being anticipated by the European Patent Application is not sustained.

The rejection of claims 34-36 under 35 U.S.C. § 102(b) as being anticipated by Bakx is sustained.

The rejection of claims 28-31 under 35 U.S.C. § 103 as being unpatentable over the European Patent Application in view of Bakx is not sustained.

The decision of the examiner is affirmed-in-part.

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<sup>4</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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